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DOCKET NO.: NIH-0239



PATENT

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Brian R. Murphy et al.

Confirmation No.: 3239

Serial No.: 09/733,692

Group Art Unit: 1648

Filing Date: December 8, 2000

Examiner: S. Brown

For: **USE OF RECOMBINANT PARAINFLUENZA VIRUSES (PIVS) AS  
VECTORS TO PROTECT AGAINST INFECTION AND DISEASE CAUSED  
BY PIV AND OTHER HUMAN PATHOGENS**

EXPRESS MAIL LABEL NO: EV251841141US  
DATE OF DEPOSIT: January 29, 2003

EV251841141US

BOX AF  
Assistant Commissioner for Patents  
Washington DC 20231

**NOTICE OF APPEAL FROM THE PRIMARY EXAMINER  
TO THE BOARD OF APPEALS**

Applicant hereby appeals to the Board of Appeals from the Decision of the Primary Examiner mailed **July 29, 2002** rejecting claims **1-98 and 122-137** of the above-identified patent application. At least one of the presently rejected claims has been previously rejected in a related application, USSN 09/083,793.

The item(s) checked below are appropriate:

1. STATUS OF APPLICANT

- ☐ Applicant(s) has previously claimed small entity status under 37 CFR §1.27.
- ☐ Applicant(s) by its/their undersigned attorney, claims small entity status under 37 CFR §1.27 as:
- ☐ an Independent Inventor
- ☐ a Small Business Concern
- ☐ a Nonprofit Organization

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02 FC:1253 930.00 CH

**REMARKS**

This appeal is based on the provisions of 37 CFR 1.191(a). As stated in MPEP 1200:

A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice or finally . . . rejected does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application.

The instant application presents the following claims:

1. An isolated infectious chimeric parainfluenza virus (PIV) comprising a major nucleocapsid (N) protein, a nucleocapsid phosphoprotein (P), a large polymerase protein (L), and a partial or complete PIV vector genome or antigenome combined with one or more heterologous gene(s) or genome segment(s) encoding one or more antigenic determinant(s) of one or more heterologous pathogen(s) to form a chimeric PIV genome or antigenome.
42. The chimeric PIV of claim 1, wherein the vector genome or antigenome is a human bovine chimeric PIV genome or antigenome.

Related application, USSN 09/586,479 presents the following, previously rejected claims:

1. An isolated infectious human bovine chimeric parainfluenza virus (PIV) comprising a major nucleocapsid (N) protein, a nucleocapsid phosphoprotein (P), a large polymerase protein (L), and a partial or complete PIV background genome or antigenome of a human PIV (HPIV) or bovine PIV (BPIV) combined with one or more heterologous gene(s) or genome segment(s) of a different PIV to form a human bovine chimeric PIV genome or antigenome.
35. The chimeric PIV of claim 1, wherein the bovine human chimeric genome or antigenome comprises a partial or

complete PIV vector genome or antigenome combined with one or more heterologous genes or genome segments encoding one or more antigenic determinants of one or more heterologous pathogens.

The Office is respectfully directed to the following exemplary cases to confirm that the originally rejected claim 35 in the 09/586,479 renders the rejection of claim 42 in the instant application subject to appeal under the "twice rejected" principle.

In re: Vogel, 164 USPQ 619, 622 (CCPA 1970)

In re: Boylan, 157 USPQ 370, 374 (CCPA 1968)

Applicants' submission of the duplicative claim 42 in the instant application was inadvertent, and the Office's consideration of the complexities of claiming in these related applications is earnestly solicited. Applicants will proceed to cancel one of the subject conflicting claims in the noted applications by way of Amendment further to this notice of appeal.

## 2. EXTENSION OF TIME

The proceedings herein are for a patent application and the provisions of 37 CFR § 1.136 apply.

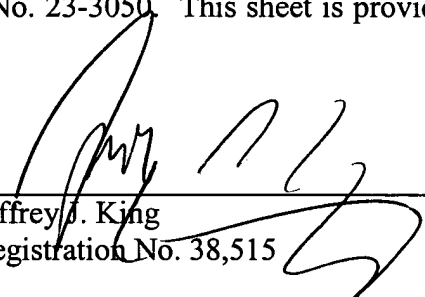
- ☒ Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 § CFR 1.17(a)(1)-(4)) for the total number of months checked below:

	SMALL ENTITY		NOT SMALL ENTITY	
	RATE	FEE	RATE	FEE
<input type="checkbox"/> ONE MONTH EXTENSION OF TIME	\$55	\$	\$110	\$
<input type="checkbox"/> TWO MONTH EXTENSION OF TIME	\$205	\$	\$410	\$
<input checked="" type="checkbox"/> THREE MONTH EXTENSION OF TIME	\$465	\$	\$930	\$930
<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME	\$725	\$	\$1450	\$
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME	\$985	\$	\$1970	\$
<input type="checkbox"/> LESS ANY EXTENSION FEE ALREADY PAID	minus	(\$ )	minus	(\$ )
<input checked="" type="checkbox"/> NOTICE OF APPEAL	\$160	\$	\$320	\$320
<b>TOTAL FEE DUE</b>		<b>\$0</b>		<b>\$1250</b>

## 3. FEE PAYMENT

- ☒ Please charge my Deposit Account No. 23-3050 in the amount of **\$1250.00**. This sheet is attached in duplicate.
- ☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account No. 23-3050. This sheet is provided in duplicate.

Date: January 29, 2003

  
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Jeffrey J. King  
Registration No. 38,515

Woodcock Washburn LLP  
One Liberty Place - 46th Floor  
Philadelphia PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439